

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re: El-Fekih et al.

Examiner: Nittaya Juntima

Serial No. 09/932,739

Group Art Unit: 2616

Filed: August 17, 2001

Confirmation No.: 4591

For: **METHODS, SYSTEMS, AND COMPUTER PROGRAM PRODUCTS FOR
MANAGING A SERVICE PROVIDED BY A NETWORK**

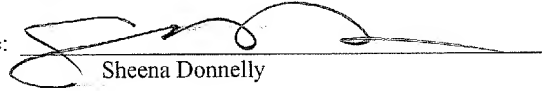
Date: June 20, 2007

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Sheena Donnelly

APPELLANTS' REPLY BRIEF ON APPEAL UNDER 37 C.F.R. §41.41

Sir:

This Reply Brief is filed in response to the Examiner's Answer mailed April 20, 2007.

It is not believed that an extension of time and/or additional fee(s) are required, beyond those that may otherwise be provided for in documents accompanying this paper. In the event, however, that an extension of time is necessary to allow consideration of this paper, such an extension is hereby petitioned for under 37 C.F.R. §1.136(a). Any additional fees believed to be due in connection with this paper may be charged to Deposit Account No. 50-0220.

I. The Examiner's Answer – Response to Argument

Appellants will refrain herein from readdressing all of the deficiencies with the pending rejections and, therefore, in the interest of brevity, Appellants hereby incorporate herein the arguments set out in Appellants' Brief on Appeal filed December 18, 2006 (hereinafter "Brief") as if set forth in their entirety. Accordingly, Appellants will only address new arguments made in the Examiner's Answer.

In the "Response to Argument" section beginning on page 14, the Examiner's Answer attempts to rebut Appellants' arguments set forth in Section I of the Brief. Appellants will respond to the arguments in the Examiner's Answer for each of these sections below.

A. Section 10 A. i of the Examiner's Answer

The Examiner's Answer states that Appellants fail to explain how the case citations on page 5 of the Brief are related to the instant application. (Examiner's Answer, page 14). The discussion on page 5 of the Brief includes case law that sets forth the requirements for establishing a prima facie case of obviousness under 35 U.S.C. §103. Claims 1, 3 - 7, 9, 11, 12, 14, 16 - 18, 20, 21, 23, 24, 46, 48 - 52, 54, 56, 57, 59, 61 - 63, 65, 66, 68, 69, 91, 93 - 97, 99, 101, 102, 104, 106 - 108, 110, 111, 113, and 114 stand rejected under 35 U.S.C. §103; therefore, Appellants submit that the case law cited on page 5 is relevant to determining whether the aforementioned claims are properly rejected under 35 U.S.C. §103.

B. Section 10 A. ii of the Examiner's Answer

The Examiner's Answer states one skilled in the art would be motivated to modify Yaakov's monitoring system with Lin's querying mechanism. (Examiner's Answer, page 14). Appellants disagree as discussed on pages 7 and 8 of the Brief. Specifically, Yaakov teaches the use of an intrusive monitoring system in which remote test units (RTU 20) are placed in series in the communication path defined by the access lines of the access unit 16. Lin, on the other hand, describes the use of an NMS 120 that collects status information from NEs in response to queries. The NMS 120 is not configured in series in the communication path to intrusively collect status information. Thus, if Yaakov's and Lin's teachings were to be combined, then status information would be intrusively collected through the remote test units placed in series in the communication path as well as through a passive mechanism of collecting status information through queries. Such a combination would be duplicative and would result in increased expense and complexity. Appellants submit, therefore, that one skilled in the art would not be motivated to combine the teachings of Yaakov and Lin for at least these reasons and the reasons discussed in the Brief.

C. Section 10 A. iii of the Examiner's Answer

The Examiner's Answer states that Appellants have not claimed intrusive or passive data collection or how a querying/data collecting device is connected to the access network. In

response, Appellants note that independent Claim 1 recites: "querying at least one access network element for the quality data..." Independent Claims 46 and 91 include similar recitations. The Final Office Action of July 12, 2006 acknowledges that Yaakov fails to teach querying an access network element for quality data, but alleges that Lin provides the missing teaching. To establish a *prima facie* case of obviousness, the prior art reference or references when combined must teach or suggest all the recitations of the claims, and there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. M.P.E.P. §2143. A patent composed of several elements is not proved obvious merely by demonstrating that each of its elements was, independently, known in the prior art. *KSR Int'l Co. v. Teleflex Inc.*, 550 U. S. 1, 15 (2007). A corollary principle is that, when the prior art teaches away from combining certain known elements, discovery of a successful means of combining them is more likely to be unobvious. *Id.* at 12. Thus, Appellants' showing that one skilled in the art would not be motivated to combine the teachings of Yaakov and Lin because their respective disclosures teach away from their combination is highly relevant in showing that the rejection of the independent claims under 35 U.S.C. §103 is improper.

The Examiner's Answer further states that Appellants' assertion that Lin describes a passive, non-intrusive mechanism for collecting status information. The Examiner's Answer on page 15 includes the following quotation in support of the proposition that Lin teaches an intrusive data collection mechanism:

In order for NMS 120 to gather status information from NE's 101-104, **each NE must either report to NMS 120 voluntarily or response to a request from NMS 120; there is no way for NMS 120 to 'passively observe' the behavior of an NE without the cooperation of the NE.** In other words, as part of its design, an NE must report a selected set of status information upon triggering of some internal or external events," (Lin, col. 6, lines 12 - 19). **"Each NE, through its associated management agent, reports to NMS 120 a set of parameter values as its operating point"** (col. 3, lines 40 - 46, emphasis added).

The text highlighted in the quote above, however, supports Appellants' position that Lin teaches passive, non-intrusive data collection. Lin states that there is no way for the NMS to passively observe an NE without the cooperation of the NE. Therefore, Lin's design is based on each NE

cooperating by reporting status information to the NMS 120, which is a passive, non-intrusive design for collecting status information.

D. Section 10 A. iv of the Examiner's Answer

The Examiner's Answer states that because the details of how an access network element is connected to a querying device is not claimed, the difference between Yaakov and Lin's designs is irrelevant. (Examiner's Answer, page 17). Appellants respectfully disagree. The difference in Yaakov and Lin's teachings is relevant to the issue of whether one skilled in the art would be motivated to combine their respective teachings. Because their disclosures teach away from their combination, the rejection under 35 U.S.C. §103 is improper. Appellants refer to Section C above and the discussion on pages 6 - 9 of the Brief.

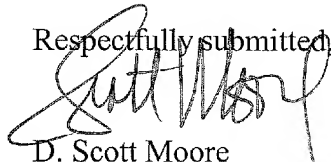
E. Section 10 A. v of the Examiner's Answer

The Examiner's Answer states that Appellants' argument that the present rejection is based on hindsight is irrelevant. (Examiner's Answer, page 17). As Appellants have shown in the above discussion and in the Brief that the combination of Yaakov and Lin is improper, Appellants respectfully submit that there appears to be no other basis for combining Yaakov and Lin other than hindsight reasoning informed by Appellants' disclosure.

II. Conclusion

For at least the reasons set forth in above and in Appellants' Brief on Appeal, Appellants request reversal of the rejections of the pending claims, allowance of the pending claims, and passing of the application to issue.

Respectfully submitted,



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